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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/428,453 10/28/99 MOTOHASHI

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FITZPATRICK CELLA HARPER & SCINTO
30 ROCKEFELLER PLAZA
NEW YORK NY 10112

EXAMINER

RODDE, C

ART UNIT

PAPER NUMBER

1753

DATE MAILED:

09/10/01

Please find below and/or attached an Office communication concerning this application or proceeding.

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Office Action Summary

Application No.
09/428,453

Applicant(s)
Motohashi et al.

Examiner
Christopher RoDee

Art Unit
1753



-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE three MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 16 Aug 2001.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 15, 22, 26, 27, and 29 is/are pending in the application.
- 4a) Of the above, claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 15, 22, 26, 27, and 29 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claims _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are objected to by the Examiner.
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- a) ☐ All b) ☐ Some* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- *See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

- 15) ☒ Notice of References Cited (PTO-892) 18) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 16) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 19) ☐ Notice of Informal Patent Application (PTO-152)
- 17) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____ 20) ☐ Other: _____

Art Unit: 1753

DETAILED ACTION

Claim Rejections - 35 USC § 112

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claims 15, 22, 26, 27, and 29 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

✓ The amended claims and new claim 29 are not described by the specification as originally filed because the only photosensitive member described is "an electrophotographic photosensitive member" (see spec. p. 1, l. 18-19; p. 7, l. 16, 23, 24). The Examiner suggests that the word "electrophotographic" be added before "photosensitive member" at each occurrence.

✓ Claims 15, 22, 26, 27, and 29 present new matter because the only disclosure of a charging member in contact with the electrophotographic photosensitive member is a charging roller in contact with the photosensitive member (spec. p. 22-23 and Figures 2 and 4).

✓ New claim 29 is also not described by the specification as filed because there is no disclosure of an image forming means as currently recited. The specification discloses an exposure means (p. 2, l. 22) and a developing means (p. 3, l. 3), but does not disclose "an image forming means" as currently presented.

Art Unit: 1753

Claim Rejections - 35 USC § 103

Claim 29 is rejected under 35 U.S.C. 103(a) as obvious over Oshiba *et al.* in US Patent 5,721,085 in view of Ishihara *et al.* in US Patent 5,363,176 or Ohmori *et al.* in US Patent 5,008,706.

Claim 29 is rejected under 35 U.S.C. 103(a) as obvious over Okado *et al.* in US Patent 5,733,702 in view of Ishihara *et al.* in US Patent 5,363,176 or Ohmori *et al.* in US Patent 5,008,706.

Claims 15, 22, 26, and 27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Oshiba *et al.* in US Patent 5,721,085 in view of Hanami *et al.* in US Patent 6,040,099.

Claim 15 has been made independent and includes some of the limitations from previously rejected claims 16-19 and 21. The previously applied rejection of Oshiba in view of Hanami applied to certain claims including claim 19 is now applicable to the process unit claims because the independent claim has been amended to include certain limitations of this claim.

The apparatus of new claim 29 requires certain means that were described in the last Office action (e.g., p. 6 for Oshiba). Additionally, the apparatus requires the presence of a contact charger. The rejections as previously applied over Oshiba and Okado have been modified by the addition of Ishihara *et al.* in US Patent 5,363,176 and Ohmori *et al.* in US Patent 5,008,706 by the new apparatus claim requiring a charging member in contact with the photosensitive member.

Ishihara discloses an electrophotographic apparatus having a photosensitive member **1**, a charging roller **2** which is in contact with the photosensitive member **1** and charges the photosensitive member to a voltage from voltage source **3** having a combined AC and DC

Art Unit: 1753

voltage, an exposure means **10**, a development means **11**, and a transfer means **12** (Figure 1 and column 4).

Ohmori discloses an electrophotographic apparatus having a photosensitive member **2**, a charging means **1** which is in contact with the photosensitive member **2** and charges the photosensitive member to a voltage from a combined AC/DC voltage source (col. 3, l. 3-10), a light beams **15** from an exposure means, a development means **16**, and a transfer means **18** (Figure 1 & col. 4, l. 59 - col. 5, l. 21).

It would have been obvious to one having ordinary skill in the art at the time the invention was made to utilize the apparatus containing the charging roller of either Ohmori or Ishihara for charging the photosensitive member of either Oshiba or Okado because each of these supporting references disclose that their contact chargers produce a uniform charge on the photosensitive member (Ishihara col. 1; Ohmori col. 2) and Ohmori further discloses that contact charging avoids the problems of oxidative species formation common with corona charging (col. 1, l. 34+).

Applicants traverse the rejection as previously set forth because the applied art does not disclose measuring the scraped particles during idle rotation (response p. 6). The scraped particles are particles of the photosensitive member only and not toner particles.

In the last Office action, the Examiner set forth reasons to believe that the photosensitive members of Okado and Oshiba inherently would produce the requisite mass of scraped particles. This assertion was based on the size and composition of certain particles incorporated into the binder of the member's surface layer. The binder and included particles had characteristics overlapping with the desired characteristics for corresponding materials in

Art Unit: 1753

the specification. Based on the common characteristics there was, and is, sufficient reason to believe that the prior art photosensitive members would produce the same mass of particles when subject to the specified testing procedure.

Applicants are understood to traverse the rejection because the references do not disclose the testing procedure to determine the mass of scraped particles, specifically, measurement during idle rotation. The Examiner agrees that the testing procedure is not disclosed by the references. However, applicants are claiming the process unit and the apparatus containing the (electrophotographic) photosensitive member having certain characteristics defined by the testing procedure. The Examiner has throughout prosecution discussed why the primary references' members are seen as having these characteristics, and applicants have not refuted the Examiner's holding of inherency.

Applicants are not claiming the testing procedure itself. No process claims are present in the instant application that could define the testing procedure as applicants' invention. Thus, applicants' remarks are not persuasive.

The cleaning member, by its own description, "cleans" the (electrophotographic) photosensitive member's surface. One of the cleaning member's ultimate purposes is to remove toner from the surface of the (electrophotographic) photosensitive member's surface (spec. p. 4, l. 9-16). The specification and the prior art both use the cleaning member to remove toner from the surface of the photosensitive member. The fact that the instant specification and claims define the characteristics of the (electrophotographic) photosensitive member on its ability to be scraped by the cleaning member without toner present (i.e., during idle rotation)

Art Unit: 1753

does not show that toner is never meant to be present on or cleaned from the surface of the (electrophotographic) photosensitive member. To the contrary, the process unit and apparatus would have little function if they were never meant to employ toner as a latent image developer.

The testing procedure does not exclude the presence of toner in the use of the process unit or apparatus. The testing procedure defines the characteristics of the (electrophotographic) photosensitive member, and the prior art appears to inherently have these characteristics for the reasons of record.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Application/Control Number: 09/428453

Page 7

Art Unit: 1753

Any inquiry concerning this communication should be directed to Exr. Christopher RoDee at telephone number 703 308-2465 or via the receptionist at 703 308-0661 for general or status inquiries. Submissions by fax may be accepted at the following telephone numbers:

Official fax: 703 872-9310
After Final fax: 703 872-9311
Unofficial fax: 703 305-6078


CHRISTOPHER RODEE
PRIMARY EXAMINER

cdr
6 September 2001